REMARKS

Claims 24 – 30 have been canceled as being drawn to a non-elected inv ntion.

Specification

The disclosure has been objected to on the basis that on page 10, line 17, US Application Serial No. 08/477,111 is improper because there is no recitation that the application is commonly assigned. The Office Action cites a case from the MPEP that indicates that a commonly assigned application *may* be incorporated by reference. There is no part of the MPEP or case law that says that an application *must* be commonly assigned to be incorporated by reference. The specific application is now issued as a patent, so the disclosure has been amended to indicate the proper patent number. A US patent may easily be obtained by anyone, so there is no impropriety in incorporating a US patent by reference. If the Examiner believes there is, it is respectfully requested that an MPEP section number be given.

Claim Rejections – 35 U.S.C. §103

The Office Action rejects claims 1 – 23 under 35 U.S.C. 103(a) as being unpatentable over Kadokura et al. (US 6,469,189) in view of Paz de Araujo et al. (US 6,110,531) and vice versa. This rejection is respectfully traversed.

Claims 1 and 23 include the limitation "applying said precursor vapor onto said substrate to produce said thin film superlattice material without any heating step that includes a temperature of 650°C or higher". The Office Action mentions all the limitations of the claim, except the above limitation. All the examples and the discussions of the process of fabrication in both the references include heating steps of applying said precursor vapor onto said substrate to produce said thin film superlattice material without any heating step that includes a temperature of 650°C or higher. It is noted that while some of the heating steps in the cited references are at temperatures less than 650°C, if the disclosures are read closely, it is seen that all examples of making thin films also include additional heating steps that are higher than 650°C. For example, in Example 4 of Kadokura et al., a heating step of 400°C is disclosed at column 11, line 26. However, in the same example at column 11, line 31, an additional heating step of 750°C is disclosed. All of the limitations of a claim must be considered

wh n weighing the differences between the clamed invention and the prior art in det rmining the obviousn ss of a method claim. MPEP 2116.01 and 2143.03. Therefore, claims 1 and 23 are patentable.

In addition, claim 23 contains the limitation of the "relative concentration of said trimethylbismuth to said solvent being 15 mol% or less". This limitation is also not disclosed in the cited art; therefore, claim 23 is patentable for this reason also.

Claims 2 – 22 depend on a patentable claim, and therefore are also patentable. *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) at headnote 4. In addition, claims 6 – 8, 12, 16, 17, and 22 include limitations not disclosed in the references. The Office Action dismisses many of these claims by stating that "it is well settled that determination of optimum values of cause effective variables such as these process parameters is within the skill of one practicing in the art". This statement is formally challenged and it is respectfully requested that support for such a statement be shown by the Examiner if the rejection is repeated. It is believed that any such reference to the case law in the integrated circuit art could easily be distinguished, because change in process parameters in the integrated circuit art is not taken lightly.

For the above reasons, claims 1 – 23 are patentable, and their reconsideration and allowance are respectfully requested. No fees are seen to be required. If any fees are required, the Commissioner is authorized to charge any such fees to Deposit Account No. 50-1848.

Respectfully submitted,

Patton Boggs, LLP

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By: _____

Carl A. Forest, Reg. No. 28,494
Tel: 303-894-6114
Fax: 303-894-9239

Customer No. 24283